UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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In re

DECISION ON
PETITION FOR REGRADE
UNDER 37 CFR 10.7(c)

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 4, 8, 11, 12 and 35 of the morning section and questions 9 and 12 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On August 2, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional two points for morning questions 11 and 12. Accordingly, petitioner has been granted an additional two points on the Examination. No credit has been awarded for morning questions 4, 8 and 35 and afternoon questions 9 and 12. Petitioner's arguments for these questions are addressed individually below.

Morning question 4 reads as follows:
4. The specification in your client's patent application has been objected to for lack of enablement. To overcome this objection, your client may do any of the following except:

(A) traverse the objection and specifically argue how the specification is enabling.

(B) traverse the objection and submit an additional drawing to make the specification enabling.

(C) file a continuation- in-part application that has an enabling specification.

(D) traverse the objection and file an amendment without adding new matter in an attempt to show enablement.

(E) traverse the objection and refer to prior art cited in the specification that would demonstrate that the specification is enabling to one of ordinary skill.

4. The model answer: (B) is the most correct answer. 35 U.S.C. § 113 reads "Drawings submitted after the filing date of the application may not be used (i) to overcome any insufficiency of the specification due to lack of an enabling disclosure." Since choice (A) may be done, 37 C.F.R. § 1.111, it is an incorrect answer to the above question. Since choice (C) may be done, 35 U.S.C. § 120, it is an incorrect answer to the above question. Since choice (D) may be done, 37 C.F.R. § 1.121, it is an incorrect answer to the above question. Since choice (E) may be done, 37 C.F.R. § 1.111, it also is an incorrect answer to the above question.

Petitioner argues that answer (C) is also correct. Petitioner contends that an objection to new matter cannot be overcome in a single application, and filing a continuation-in-part merely allows the original application to die.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that an objection to new matter cannot be overcome in a single application, and filing a continuation-in-part merely allows the original application to die, the question does not restrict the overcoming to a single application. The objection will, in fact, be overcome in the continuation-in-part. In addition, the petitioner should note that continuation-in-part application is entitled to the benefit of the earlier filing date of the parent application, except for subject matter directed ***solely*** the added subject matter filed in the continuation-in-part application. Accordingly, model answer (B) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 8 reads as follows:

8. On March 20, 2000, Patsy Practitioner filed a patent application on widget Y for the ABC Company based on a patent application filed in Germany for which benefit of priority was claimed. The sole inventor of widget Y is Clark. On September 13, 2000, Patsy received a first Office action on the merits rejecting all the claims of widget Y under 35 U.S.C. § 103(a) as being obvious over Jones in view of Smith. When reviewing the Jones reference, Patsy notices that the assignee is the ABC Company, that the Jones patent application was filed on April 3, 1999, and that the Jones patent was granted on January 24, 2000. Jones does not claim the same patentable invention as Clark's patent application on widget Y. Patsy wants to overcome the rejection without amending the claims. Which of the following replies independently of the other replies would not be in accordance with proper USPTO practice and procedures?

(A) A reply traversing the rejection by correctly arguing that Jones in view of Smith fails to teach widget Y as claimed, and specifically and correctly pointing out claimed elements that the combination lacks.

(B) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.131 that antedates the Jones reference.

(C) A reply traversing the rejection by relying on an affidavit or declaration under 37 CFR 1.132 containing evidence of criticality or unexpected results.

(D) A reply traversing the rejection by stating that the invention of widget Y and the Jones patent were commonly owned by ABC Company at the time of the invention of widget Y, and therefore, Jones is disqualified as a reference via 35 U.S.C. § 103(c).

(E) A reply traversing the rejection by perfecting a claim of priority to Clark's German application, filed March 21, 1999, disclosing widget Y under 35 U.S.C. § 119(a)-(d).

8. The model answer: The correct answer is (D). The prior art exception in 35 U.S.C. § 103(c) only applies to references that are only prior art under 35 U.S.C. § 102(e), (f), or (g). In this situation, the Jones patent qualifies as prior art under § 102(a) because it was issued prior to the filing of the Clark application. See MPEP § 706.02(l)(3). ~~Also, evidence or common ownership must be, but has not been, presented. Mere argument or a statement alleging common ownership does not suffice to establish common ownership.~~ Answer (A) is a proper reply in that it addresses the examiner's rejection by specifically pointing out why the examiner failed to make a prima facie showing of obviousness. See 37 C.F.R. § 1.111. Answer (B) is a proper reply. See MPEP § 715. Answer (C) is a proper reply. See MPEP § 716. Answer (E) is a proper reply because perfecting a claim of priority to an earlier filed German application disqualifies the Jones reference as prior art.

Petitioner argues that the question is unanswerable. Petitioner contends that the facts do not indicate what paragraph of 35 USC 102 is applied in connection with 35

USC 103. The petitioner further contends that the question requires an assumption that the Jones patent is a valid reference under 35 U.S.C. 102(a).

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the facts do not indicate what paragraph of 35 USC 102 is applied in connection with 35 USC 103, the fact pattern clearly states that the rejection is based on 35 USC 103 rather than 35 USC 102. To the extent the petitioner is arguing that the requires an assumption to be made that the Jones patent is a 35 USC 102(a) type reference for the purpose of overcoming a common assignee argument, the facts clearly indicate that the reference is a 35 USC 102(a) type reference, and there is no need to assume any fact. In any event, the burden is on the applicant to overcome the 35 USC 103 rejection, and that cannot be done by responding in a way provided for in selection (D) alone, making selection (D) the best answer. Accordingly, model answer (D) is correct.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 9 reads as follows:
9. An applicant's claim stands rejected under 35 U.S.C. § 103 as being obvious over Larry in view of Morris. Larry and Morris are references published more than one year before applicant's effective filing. Although the examiner cites no suggestion or motivation for combining the references, they are, in fact, combinable. Which of the following arguments could properly show that the claim is not obvious?

(A) The inventions disclosed by Larry and Morris cannot be physically combined.

(B) Neither Larry nor Morris provides an express suggestion to combine the references.

(C) As recognized by businessmen, the high cost of Larry's device teaches away from combining it with the simpler device of Morris.

(D) Absent a suggestion or motivation, the examiner has not shown that combining Larry's with Morris's device would have been within the level of ordinary skill of the art.

(E) None of the above.

9. The model answer: (D) is correct. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Here, the examiner fails to show that substituting Larry's device for another type of device in Morris would have been desirable. (A) is incorrect. The test of obviousness is not whether the features or elements of the references are physically combinable. *In re Keller,* 642 F.2d 413, 425, 208 USPQ

871, 881 (CCPA 1981); *In re Sneed,* 710 F.2d 1544,1550, 218 USPQ 385,389 (Fed. Cir. 1983). (B) is incorrect. "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law." MPEP § 2144 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)). Here, the argument overlooks the fact that a suggestion to combine Larry and Morris may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. (C) is incorrect. "The fact that a combination would not be made by businessmen for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility." MPEP § 2145 (citing *In re Farrenkopf*, 713 F.2d 714, 718, 219 USPQ 1, 4 (Fed. Cir. 1983)). Here, the high cost of Larry's device does not teach away from a person of ordinary skill in the art combining it with Morris' device.

Petitioner argues that answer (E) is the most correct answer as model answer (D) is equally incorrect as answers (A), (B) and (C). Petitioner contends a showing that the claim is not obvious could be achieved by a showing that the examiner has not established a *prima facie* case of obviousness. Petitioner further contends that such a showing was not one of the selected answers, thereby making answer (E) the most correct.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that that none of the selected answers provide a showing that the examiner failed to establish a *prima facie* case of obviousness, this is not the case. Answer (D) states that absent motivation to combine that was within the skill of one of ordinary skill in the art, obviousness is not shown. Answer (D) does, indeed, illustrate that the examiner failed to meet his or her burden in establishing a *prima facie* showing of obviousness. Accordingly, model answer (D) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 12 reads as follows:
12. An applicant's claim stands rejected as being obvious under 35 U.S.C. § 103 over Lance in view of Barry. Lance and Barry are patents that issued and were published more than one year before applicant's effective filing date. Which of the following arguments could properly overcome the rejection?

(A) Barry's device is too large to combine with Lance's device.

(B) The Barry reference is nonanalogous art, because, although pertinent to the particular problem with which Lance was concerned, it relates to a different field of endeavor that the applicant's invention.

(C) The combination of Lance and Barry would have precluded Lance's device from performing as Lance intended.

(D) The Barry reference does not show all of the claimed elements arranged in the same manner as the elements are set forth in the claim.

(E) All of the above.

12. The model answer: (C) is correct. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Here, the combination would render Lance's device unsatisfactory for its intended purpose. (A) is incorrect. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference .... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." MPEP § 2145, paragraph III (quoting *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). Here, the argument fails to address what the combined teachings of the references would or would not have suggested to those of ordinary skill in the art. (B) is incorrect. "'In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.'" MPEP § 2141.01(a) (quoting *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)). Here, Barry's art could still be analogous if it was reasonably pertinent to the particular problem with which the applicant was concerned. (D) is incorrect. The argument addresses a rejection under 35 U.S.C. § 102, as opposed to the rejection that was made, under 35 U.S.C. § 103, which raises obviousness, not anticipation, issues. (E) is not correct because (A), (B) and (D) are incorrect.

Petitioner argues that answer (B) is correct. Petitioner contends that the question is vague and answer (B) could be correct because the Barry reference is nonanalogous art, because, it relates to a different field of endeavor than the applicant's invention.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that (B) could be the correct answer, test takers are supposed to pick the best answer. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal

Register. Answer (C) is the correct answer because an argument that the combination of references would have precluded Lance's device from performing as Lance intended could properly overcome a 103 rejection. An argument that the Barry reference is nonanalogous art, because it relates to a different field of endeavor that the applicant's invention would not overcome a 103 rejection because that only satisfies part of the test as to whether the reference is nonanalogous art. Accordingly, model answer C is the most correct answer, and petitioner's answer B is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 35 reads as follows:
35. Joe Inventor received a patent in July 1999, containing claims to both an article and an apparatus. When filed in the USPTO, the application contained disclosure of a method, but the method was not claimed. The patent contained the same disclosure of the method, but the method had never been claimed in the application. In May 2001, Joe asks Pete Practitioner to file a reissue application to add claims to the method disclosed in the specification. Once filed, which of the following will most likely occur during the prosecution of the reissue application in accordance with published USPTO practice and procedure?

(A) The examiner should reject the added method claims on the basis of not being for the invention claimed in the original patent, under 35 U.S.C. § 251, citing *In re Rowand*, 187 USPQ 487, and allow the original unamended article and apparatus patent claims in the reissue application.

(B) Following a restriction requirement by the examiner in the reissue application, the original unamended article and apparatus patent claims will be constructively elected, examined, and, if found allowable, passed to issue, while the non-elected method claims should be filed in a divisional application.

(C) Following a restriction requirement in the reissue application and the filing of a divisional application to claim the method, the applicant should request a duplicate copy of the original patent so that a copy of said patent can be surrendered in each reissue application.

(D) Following a restriction requirement by the examiner in the reissue application, the original unamended article and apparatus patent claims will be considered constructively elected; if after examination they become allowable in unamended form, they will be held in abeyance in a withdrawn status inasmuch as no "error" under 35 U.S.C. § 251 exists, while Joe prosecutes the claims to the method in a divisional application.

(E) A three-way restriction requirement among the article, apparatus and method claims should be made by the examiner in the reissue application, and an election made by applicant. Each invention should issue in a separate reissue patent.

35. The model answer: The correct answer is (D). The practice is set out in MPEP § 1450. (A) is incorrect since the CAFC decision of *In re Amos*, 21 USPQ 2d 1271, held that reissue applicants have a right to claim any disclosed subject matter satisfying the first paragraph of 35 U.S.C. § 112. MPEP §1412.01. (A) and (B) are incorrect because the Office cannot reissue original unamended patent claims (where no error under 35 U.S.C. § 251 is corrected). (C) is incorrect because the original patent can only be surrendered once. USPTO has procedures for transferring the original patent grant from a reissue application to an divisional reissue application. USPTO procedures do not provide for surrendering a duplicate copy of an original patent grant. Reference may be made to the application in which it is surrendered. MPEP § 1416(E) is incorrect since 37 C.F.R. § 1.176 only authorizes restriction between the originally claimed subject matter of the patent and previously unclaimed subject matter.

Petitioner argues that answer (B) is correct. Petitioner contends that failure to claim the method claims is the error required by 35 U.S.C. 251 so that there is no need to hold the original apparatus claims in abeyance while the method claims are being examined.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that there is no need to hold the application only containing the unamended original apparatus claims in abeyance, 35 U.S.C. 251 does require it. While it is true that the failure to claim the method claims is a permissible "error" under 35 U.S.C. 251, the application that only contains the apparatus claims cannot state that failure to claim the method is its error because that reissue application still does not claim the method (i.e., the method claims were cancelled as being nonelected claims). Therefore, in order to be a proper error, the application containing only the apparatus claims must be held in abeyance until such time that the method claims prosecuted in the divisional reissue are found allowable and rejoined. Accordingly, model answer D is correct and petitioner's answer B is incorrect.

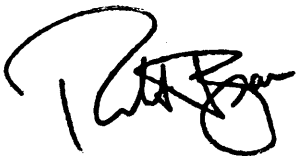
No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, two points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



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